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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,957	04/19/2001	Kent Wendorf	81862.P247	4512

8791 7590 04/12/2007  
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EXAMINER
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RYMAN, DANIEL J

ART UNIT	PAPER NUMBER
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2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/839,957

Applicant(s)

WENDORF ET AL.

Examiner

Daniel J. Ryman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-48 is/are allowed.
- 6) ☒ Claim(s) 34-43 and 49-53 is/are rejected.
- 7) ☒ Claim(s) 39, 41 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Examiner acknowledges Applicant's filing of an RCE on 28 March 2007.
2. Applicant's arguments with respect to claims 34-43 and 49-53 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claim 39 is objected to because of the following informalities: it is unclear whether the phrases used in line 2 ("module for storing") and lines 6-19 ("module for: calculating. . . ; selecting . . . ; incrementing . . . ; asserting . . . ; deasserting . . . ; transmitting . . . ; and updating") are intended to invoke 35 U.S.C. § 112, 6<sup>th</sup> paragraph. See MPEP § 2181(I). If so, Applicant should amend the claim to follow the "means plus function" format, which clearly signals invocation of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. If not, Applicant should amend these phrases to "module to store" and "module to: calculate. . . ; select. . . ; increment. . . ; assert. . . ; deassert. . . ; transmit. . . ; and update," respectively. Appropriate correction is required.
4. Claim 41 is objected to because of the following informalities: it is unclear whether the phrase used in line 2 ("module further for: incrementing . . . ; decrementing") is intended to invoke 35 U.S.C. § 112, 6<sup>th</sup> paragraph. See MPEP § 2181(I). If so, Applicant should amend the claim to follow the "means plus function" format, which clearly signals invocation of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. If not, Applicant should amend the phrase to "module further to: increment. . . and decrement." Appropriate correction is required.
5. Claim 43 is objected to because of the following informalities: it is unclear whether the phrase used in line 2 ("module further for deasserting . . . and resetting") is intended to invoke 35

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U.S.C. § 112, 6<sup>th</sup> paragraph. See MPEP § 2181(I). If so, Applicant should amend the claim to follow the “means plus function” format, which clearly signals invocation of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. If not, Applicant should amend the phrase to “module further to deassert . . . and reset.” Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 34-43 and 49-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. To comply with the subject matter eligibility requirement of 35 U.S.C. § 101, a claim must pass the following test: (1) Does the claimed invention fall within one of the statutory classes? If not, then the claim is non-statutory. (2) If it does, does the claimed invention fall/cover/include a judicial exception? If not, the claim is statutory. If so, the claim is only statutory if there is a practical application (a) by physical transformation or (b) that produces a useful and tangible result.

9. In this case, claims 34-38 (directed to a method) and claims 39-43 (directed to a system) meet Question One since they fall within either the “process” or “machine” statutory classes of 35 U.S.C. § 101. However, these claims fail Question Two since they fall within a judicial exception, i.e. the claims are an attempt to seek patent protection of a computer program in the abstract. This is evidenced by claims 49-53 which demonstrate that, with respect to claims 34-43, the method may be implemented using computer programs and that, with respect to claim 39-43, the scheduler module may be implemented using computer programs. Since the claims are

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merely trying to claim a “computer code” in the abstract, the claims fall within the “abstract idea” judicial exception.

10. Once the answer to Question Two is “yes,” i.e. the claimed invention falls under a judicial exception, the claimed invention is only statutory if it produces either a practical application by physical transformation or a practical application that produces a useful and tangible result. In this case, there is no practical application by physical transformation since neither the method nor the scheduler module manipulate any physical structure. In addition, there is no practical application that produces a useful and tangible result since, when implemented in software, the claims never require that the software be executed by a computer. Therefore, the claims are non-statutory.

11. In order to make claims 34-43 statutory, Applicant could amend the claims to turn the method steps into structural limitations, e.g. “means for calculating” and “means for selecting”. Applicant could also amend the claims to turn the claims into a purely “software” claim by amending the claims to read, for example, “A computer-readable medium encoded with a data structure [or software] for calculating . . .”

12. Claim 49 recites: “A computer readable medium storing executable instructions, which, when executed in a processing system, cause the processing system to perform a method.” However, current USPTO practice requires that software be claimed in a manner that requires execution on a *computer*. Any other language fails to define structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized. As such, any other

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language for claiming a computer program is non-statutory. Therefore, Applicant should amend the preamble of claims 49 and 50 to recite "a computer" rather than "a processing system."

***Allowable Subject Matter***

13. Claims 44-48 are allowed. The prior art does not disclose or fairly suggest using a speed-up signal and a speed-up counter as provided for in these claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel J. Ryman  
Examiner  
Art Unit 2616

*Daniel Ryman*